

## **REMARKS**

### **The Amendments**

The claims are amended to direct the invention to the compounds of previous claim 9, excluding one of the species. The claims are further amended to address the claim objections and 35 U.S.C. §112 rejection and, otherwise, present the claims in a form more customary to US practice. These latter amendments do not narrow the scope of the claims.

To the extent that the amendments avoid the prior art or for other reasons related to patentability, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art or otherwise unpatentable to applicants. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

### **The Claim Objections**

The objections to claims 10, 11 and 21 are believed to be rendered moot by the above amendments.

### **The Rejections under 35 U.S.C. §112, second paragraph, and under 35 U.S.C. §101**

The rejection of claims 1-9, 13, 14-20, 22 and 23 under 35 U.S.C. §112, second paragraph, are believed to be overcome by the above amendments. The "use" claims 14-20 are replaced with method claims more common to US practice. This also overcomes the 35 U.S.C. §101 rejection. The "derivatives" term in the claims is now defined in accordance

with the disclosure at page 9, lines 16-23. The claims now provide a definite indication of the types of derivatives contemplated. Thus, the rejection should be withdrawn.

**The Rejection under 35 U.S.C. §112, first paragraph**

The rejection of claims 1-9, 11-15 and 22-23 under 35 U.S.C. §112, first paragraph, is respectfully traversed. The rejection is made on the basis that the "solvate" term as used in the claims lacks enablement. Applicants respectfully submit that one of ordinary skill in the art using the knowledge known in the art and the disclosure provided by the instant specification could prepare solvates of the claimed compounds without undue experimentation. This is not a situation akin to the *Morton International* decision cited in the Office Action. In that decision, lack of enablement was found because the connectivity purported in the claims was not known in the art and was unusual to the art, therefore, the absence of examples led to lack of enablement. In the instant case, the ability to form solvates of many compounds is well known to those of ordinary skill in the art. Solvates are common derivatives of compounds similar to salts. As described at page 10, lines 9-14, of the specification, the term solvates of the compounds is taken to mean adductions of inert solvent molecules onto the compounds which form owing to their mutual attractive force and examples of monohydrates, dihydrates or alcoholates are given. It is true that the specification provides no specific examples of preparing solvates but such is unnecessary in this situation where there preparation would be commonly known to those skilled in the art. As stated by the CAFC in *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1534, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987), and repeated in many following cases, "a patent need not teach, and preferably omits, what is well known in the art." Based on the knowledge already available to one of ordinary skill in the art, the teaching in the specification regarding

solvates is sufficient to enable one of ordinary skill in the art to practice the invention without the need to resort to undue experimentation. Preparing solvates from the compounds recited in the claims would be merely routine to one of ordinary skill in the art. In this situation, the claims are enabled and the rejection under 35 U.S.C. §112 should be withdrawn.

### **The Rejections under 35 U.S.C. §102 and 35 U.S.C. §103**

The rejections of the claims under 35 U.S.C. §102 and 35 U.S.C. §103 are respectfully traversed.

Only one of the rejections is made applicable to claim 9. The current claims recite the substance encompassed by claim 9, excluding one further compound. Thus, all of the rejections which were not applied to claim 9 are believed to be rendered moot. None of the references cited therein disclose a compound as recited in the now independent claim 9.

The only rejection which was applied to claim 9 was the rejection under 35 U.S.C. §102 based on Abdelhamid et al. (*Heterocycles*). The compound disclosed by Abdelhamid on page 1862, compound 7, is no longer included within the scope of the claims; see the amendment to claim 9 excluding that compound. Thus, the instant claims are not anticipated by Abdelhamid and the rejection under 35 U.S.C. §102 should be withdrawn.

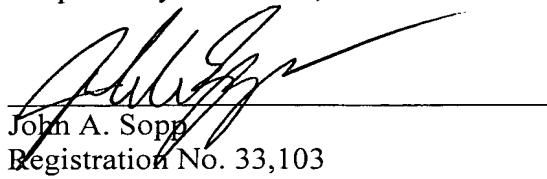
Abdelhamid also fails to render the claimed invention obvious under 35 U.S.C. §103. The reference discloses no utility for the compounds disclosed therein and, thus, provides no motivation to one of ordinary skill in the art to modify such compounds even to compounds which are allegedly structurally similar; see, e.g., *In re Stemniski*, 170 USPQ 343 (CCPA 1971).

For all of the above reasons, it is urged that all of the prior art rejections should be withdrawn.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matter.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



John A. Sopp  
Registration No. 33,103  
Attorney for Applicants

MILLEN, WHITE, ZELANO  
& BRANIGAN, P.C.  
Arlington Courthouse Plaza 1  
2200 Clarendon Blvd. Suite 1400  
Arlington, Virginia 22201  
Telephone: (703)243-6333  
Facsimile: (703) 243-6410  
Attorney Docket No.: MERCK-2893

Date: September 1, 2006